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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,673	03/23/2004	Andy Clough	969-001	1413

37468 7590 02/17/2005

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EXAMINER

HWU, JUNE

ART UNIT PAPER NUMBER

1661

DATE MAILED: 02/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/806,673

Applicant(s)

CLOUGH, ANDY

Examiner

June Hwu

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Art Unit: 1661

DETAILED ACTION

Drawings

The drawings have been approved.

Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

In plant application filed under 35 U.S.C. 161, the requirements of 35 U.S.C. 112 are limited.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164

(reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

Art Unit: 1661

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 37 CFR 1.163(a) because the specification presents less than a full and complete botanical description and the characteristics which distinguish over related known varieties.

More specifically:

A. The Latin name of the genus, species and variety denomination of the claimed plant should be stated and preceded by the heading set forth in 37 CFR 1.163(c)(4), (c)(5) and (d). See MPEP 1605.

B. Applicant should refer to cultivar names within single quotation marks, as this is the convention employed by the International Code of Botanical Nomenclature.

C. Applicant must provide more meaningful color description for the instant variety with reference to a recognized color chart, such as the RHS Colour Chart. Applicants should supplement the general color descriptions currently set forth with color designations from the employed color chart rather than general color terms, for such botanical features as bark, foliage (upper and lower surface), leaf venation, branch, lenticels, petiole, winter leaf buds, male catkins, female inflorescence, husk, nut, and kernel. See MPEP § 1605.

Art Unit: 1661

D. Applicant should set forth in the specification the age of the observed tree at a given culture

E. Applicant should set forth in the specification the average plant height and spread.

F. Page 3, lines 17-18, the recitation with regard to the description of the foliage is insufficient. Applicant should set forth in the specification the foliage average size in the interest of providing as complete a botanical description of the plant as is reasonably possible.

G. Applicant should set forth in the specification the leaflet's average size, shape, number, apex and base shapes, surface texture (upper and lower surfaces), and margin type in the interest of providing as complete a botanical description of the plant as is reasonably possible.

H. Applicant should set forth in the specification the petiole's average size (length and diameter) and surface texture in the interest of providing as complete a botanical description of the plant as is reasonably possible.

I. Page 3, lines 23-24, the recitation regarding the bud's description is insufficient. Applicant should set forth in the specification the winter leaf bud's shape, size, and surface texture in the interest of providing as complete a botanical description of the plant as is reasonably possible.

Art Unit: 1661

J. Applicant should set forth in the specification the surface textures of the branch and trunk in the interest of providing as complete a botanical description of the plant as is reasonably possible.

K. Applicant should set forth in the specification the lenticel's shape and size on the trunk and branch in the interest of providing as complete a botanical description of the plant as is reasonably possible.

L. Page 4, lines 1-2, the description with regard to the male catkins is insufficient. Applicant should set forth in the specification the catkin's average size (length and diameter) and number of stamens in the interest of providing as complete a botanical description of the plant as is reasonably possible. In addition, the term "catskins" is misspelled and should be changed to read -- catkins --.

M. Page 4, line 2, the recitation with regard to the female inflorescence is insufficient. Applicant should set forth in the specification the female flower shape, flower spike size, and number of flowers per spike in the interest of providing as complete a botanical description of the plant as is reasonably possible.

N. Applicant should set forth in the specification the first and last blooming dates of female inflorescence and male inflorescence at a given time of culture.

O. Page 4, lines 7-8, Applicant should clarify the various diseases that the instant cultivar is resistant to.

P. Page 4, line 14, the recitation "Schuck split" is unclear. Clarification is necessary.

Q. Applicant should set forth in the specification the husk's average size, shape, surface texture, and thickness in the interest of providing as complete a botanical description of the plant as is reasonably possible.

R. Applicant should set forth in the specification the nut's shape, basal and apex shape, thickness, size, and surface texture in the interest of providing as complete a botanical description of the plant as is reasonably possible.

S. Page 4, line 18, the recitation "*Cluster size*. Generally 3 to 5" does not describe the size of the nut cluster but the number of nuts per cluster. Correction is necessary.

T. Applicant should set forth in the specification the kernel's average weight, flavor, firmness, and shape in the interest of providing as complete a botanical description of the plant as is reasonably possible.

U. Applicant should set forth in the specification the cracking and shelling qualities of the nut.

V. Page 5, line 2, the recitation "45 cmt" is unclear. Clarification is necessary.

Art Unit: 1661

W. Applicant should set forth in the specification the last picking date of the nut at a given time of culture.

The above listing may not be complete. Applicants should carefully compare the claimed plant with the botanical descriptions set forth in the specification to ensure completeness and accuracy and to distinguish the plant within this expanding market class. Any further botanical information should be imported into the specification, as should any additional or corrected information relative to same.

Claim Rejection

35 USC § 112, 1st and 2nd Paragraphs

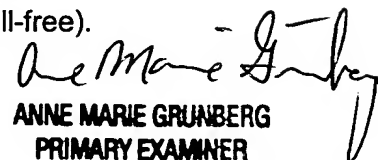
Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for reasons set forth in the Objection to the Disclosure Section above.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to June Hwu whose telephone number is (571) 272-0977. The Examiner can normally be reached Monday through Thursday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Wang, can be reached on (571) 272-0811. The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


ANNE MARIE GRUNBERG
PRIMARY EXAMINER